

The Examiner contends that the inventions are distinct, each from the other.

Further, the Examiner has required an election of species within each group for prosecution on the merits, to which the claims shall be restricted if no generic claim is held to be allowable, as follows:

If Group I is elected, the Examiner has required an election from among the following species:

- A. methods involving the toporythmic protein Delta (98, 103, 106, 109, 110, 113, 115 and 118);
- B. methods involving the toporythmic protein Serrate (98, 105, 106, 109, 111, 113, 116 and 119); and
- C. methods involving Notch protein, fragments, or analogs (104, 106, 109, 112, 113, 114 and 117).

If Group II is elected, the Examiner has required an election from among the following species:

- A. methods involving antibodies or inhibitors of Notch (94-96, 107, 108 and 120-123);
- B. methods involving antibodies or inhibitors of Delta (94, 95 and 120-123); and
- C. methods involving antibodies or inhibitors of Serrate (94, 95 and 120-123).

Preliminarily, Applicants wish to point out that Applicants believe that the Examiner has made certain errors in determining which claims encompass promotion or antagonism of Notch function. Claims 99, 101, 104, 112 and 117 should also be included in Group II, since these claims are directed to types of molecules that can include antagonists of Notch function. For example, the extracellular domain of Notch or a portion thereof (claim 99), or a Notch fragment (claim 101), or a soluble Notch protein (claim 104), or a Notch protein (claim 117) may competitively inhibit Notch binding to a Notch ligand. Claim 102 should be in Group II since a Notch antisense oligonucleotide (claim 102) antagonizes Notch

function. Thus, claims 99, 101, 102, 104, 112 and 117 should be included in Group II. Claims 106, 109, 113, 114, 115 and 116, while included in Group I, also should be in Group II, since these claims are directed to methods which can encompass promoting as well as antagonizing Notch function. Claims 94-97 and 120-123, while in Group II, should also be included in Group I since antibodies can be activating as opposed to inactivating.

Based on the foregoing, Applicants believe that the division of the claims into the subject matter specified by the Examiner should have been as follows: Claims 90, 92, 94-99, 101, 103-106 and 109-123 in Group I, and claims 90, 91, 93-97, 99-102, 104, 106-109, 112-117 and 120-123 in Group II.

In order to be fully responsive, Applicants hereby provisionally elect with traverse the invention of Group I, claims 90, 92, 94-99, 101, 103-106, 109-123, drawn to a method of manipulating cell differentiation by promoting Notch function, classified in Class 424, subclass 130.1+. Further, Applicants provisionally elect with traverse species A of Group I, claims 98, 103, 106, 109, 110, 113, 115 and 118, drawn to methods involving the toporythmic protein Delta.

With respect to the Examiner's division of the invention into two groups and the reasons stated therefor, Applicants respectfully traverse. As discussed above, there is substantial overlap between the two groups as to whether the claims encompass methods involving antagonism or promotion of Notch function. Moreover, it is not even necessary to determine whether promotion or antagonism is occurring in many of the claimed methods, e.g., claims 113-123, since these methods are, *inter alia*, enabled and definite without such a determination.

Even assuming *arguendo* that Groups I and II represent distinct or independent inventions, Applicants submit that to search the subject matter of all the Groups together would not be a serious burden on the Examiner.

The M.P.E.P. § 803 (Sixth Edition, Rev. 2, July 1996) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, these two groups should be examined in one application since examining these two groups together would not pose a serious burden for the examiner.

Thus, in view of M.P.E.P. § 803, all of claims 90-123 should be searched and examined in the present application.

Furthermore, even assuming, *arguendo*, that Groups I and II constituted distinct related inventions, such inventions should not be divided since these groups are all classified in the same class and subclass, the field of search would be the same, and there is no indication otherwise. As stated by MPEP § 808.02 (Sixth Edition, Rev. 2, July 1996):

Where, however, the classification is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

Thus, in view of MPEP § 808.02, the restriction requirement, at a minimum, should be modified to combine Groups I and II.

Accordingly, Applicants respectfully request that the Restriction Requirement under 35 U.S.C. § 121 be withdrawn and present claims 90-123 be examined in one application.

Applicants retain the right to petition from the restriction requirement under 47 C.F.R. § 1.144.

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the present application.

Respectfully submitted,

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Enclosure